

REMARKS

In accordance with the foregoing, claim 3 has been amended to correct an apparent typographical error without narrowing the scope of the claim. No new matter has been added.

Claims 1-32 are pending and under consideration.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect claims 3-28 (Group II) in response to the preliminary restriction requirement set forth in the Office Action.

Further, applicants provisionally elect claims 12-28 (Species II-d) in response to the preliminary requirement for election of species set forth in the Office Action.

Lastly, on page 3 of the Office Action, the Examiner asserts that no claims are considered generic between Species II-a through II-d. However, it is respectfully submitted that at least claim 12 is generic to the species at least to the extent that claim 12 does not set forth a specific generation element, whereas claims 3, 6, and 9 recite a specific generation element, and since claim 12 sets forth a lead unit having a safety device, whereas claims 3, 6, and 9 recite specific lead units as set forth therein. As such, it is respectfully requested that the Examiner reconsider and withdraw the statement that no claims are generic within Group II.

II. Applicants Traverse the Restriction Requirement

On page 2 of the Office Action, the Examiner asserts that claims 1, 2, and 29-32 of Group I are drawn to a PTC protector, and claims 3-28 of Group II are drawn to a lithium battery. The Examiner further asserts that the Group I claims are intermediates and can be used in motors and fuel cells other than the final product in Group II. However, it is respectfully submitted that the Examiner's analysis does not account for the features of the claims as recited as is required in determining distinctiveness sufficient to require restriction.

By way of review and example, claim 1 of Group I recites, among other features, a protector having a positive temperature coefficient element (PTC), whereas claim 3 of Group II recites, among other features, a battery including a positive temperature coefficient element (PTC). As such, even assuming arguendo that there is a potential for separate utility for the features as construed by the Examiner, the Examiner's assertions do not accurately reflect the features of the claims of Groups I and II as recited.

As noted in MPEP 806.05(c), related inventions such as intermediate-final products and combinations/subcombinations may be different inventions where “it can be shown that a combination *as claimed*: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations” (italics added). As such, the focus in determining whether the combination (final product) is different from a subcombination (intermediate) is based upon the claimed invention. As the claims of Group II generally recite a battery using a protector of Group I, it is respectfully submitted that the Examiner has not analyzed the invention of Group I to determine if, *as claimed*, the protector of Group I is both separately usable from the invention of Group II and the battery of Group II does not require the particulars of the protector of Group I. Therefore, it is respectfully submitted that the Examiner has not set forth sufficient evidence that the invention as claimed in claims 1, 2, and 29-32 is separately usable from the invention as claimed in claims 3-28 as is required to maintain a prima facie restriction requirement under the two way standard set forth in at least MPEP 806.05(c).

Insofar as Groups I and II are concerned, it is believed that claims of Group I are so closely related to elected claims Group II that they should remain in the same application to avoid imposing any undue burden, expense, and delay on the Applicants in preserving the invention recited in the claims of Group I. Specifically, in searching for the invention of Group II, it is believed that the Examiner’s search would naturally encompass both technologies.

There have further been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing claims for both disk drives and disk cartridges in the same field of technology. While it is noted that the Examiner has identified different classifications for the claims in Groups I and II, it is believed that classification is not conclusive on the question of restriction and it is unclear if the classification of Group II accounts for the recited features contained therein. As such, beyond showing separate classifications in subclasses of the same class, it is respectfully submitted that the Examiner has not set forth sufficient evidence to show that the Examiner will experience a serious burden without imposing restriction which is out of proportion with the serious burden and inconvenience visited upon the applicant if restriction is required.

III. Applicants Traverse the Election Requirement

On page 3 of the Office Action, the Examiner asserts that applicants must elect between species drawn to a lithium battery having a PTC (Species II-a), a lithium battery with a PTC and

a lead made of nickel and a clad material (Species II-b), a lithium battery with an input lead connector to a PTC (Species II-c), and a lithium battery with a power generation element (Species III-d). Consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election, the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species.

The Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Species II-a through II-d. Specifically, the Examiner has not provided evidence that the existence of four species represents an unreasonable number of species to be searched, and has not provided a rationale as to why the invention is to be separated into Species II-a through II-d. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species II-a through II-d which is out of proportion with the delay and expense visited on the applicants in protecting the invention recited in Species II-a through II-c so as to show an undue burden on the Examiner or an unreasonable number of species so as to also require an election between these species. As such, it is respectfully requested that the Examiner reconsider and withdraw the election.

IV. Conclusion

Upon review of references involved in this field of technology, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application. In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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